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EXAMINER

BUTLER, MICHAEL E

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3653

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/014076
Filing Date: 1/27/98
Appellant(s): McGrady et al..

Ralph S. Jocke
For Appellant

MAILED

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GROUP 3600

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 3/9/01.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. The appellant's brief states there are no related appeals or interferences.

A related appeal with common lead inventor, assignee, representative and PTO work group was discovered during consultation with another examiner. Applicant has requested nondisclosure of an application number of a related appeal to avoid opening that application to the public. Such confidentially measures are intended to prevent disclosure of applicant inventions. The instant invention is fully disclosed and currently in the teachings now in the public domain through patent numbers 6163737, 6108588, and 5971593 among others, bearing common disclosures with the instant application. However, per applicant's request, since an alternate internal PTO-only identification process exists, related case is identified by the appeal number 992631 rather than application number.

As a dispute of relevance exists with applicant in contrast to the concurring opinions of the examiner of the related case and the instant, the Board is well suited to determine relevance and if any claims are allowed can authorize expungement of the related appeal number if Board holds the related appeal irrelevant.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is substantially correct.

(4) *Status of Amendments After Final*

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The appellant's statement of the status of amendments after final rejection contained in the first paragraph of section (4) of the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief are broadly correct as summarizing the claims' status. However, the statement of issues fails to detail the factual and legal issues determinative on the status of the claims.

Does a reference receive the effective 102(e) priority date benefit for matter mutually disclosed in an earlier claimed application if one of the claim links is merely a CIP link?

Does the subject matter of a dependent claim inherit the invention date of the base claim?

If the subject matter of a dependent claim would have been obvious to invent, may a dependent claim inherit the invention date of the base claim?

Whether the Pearson references feature a dispensing mechanism?

Whether Pearson disclose authorized users?

Whether Pearson disclose dispensing sensors?

Whether Pearson disclose a plurality of users?

Whether Pearson disclose modifying data?

Whether Pearson dispense containerize medicaments?

Whether an electrical engineer of ordinary skill in the art would know how to interface a data reading device to a CPU?

Whether it would be obvious to unlock the locked medicament drawers of Halverson with the CPU used to control the locks?

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Whether it would have been obvious for Halverson to enter Patient data with the data entry devices?

Whether PTO proceedings are subject to the Administrative Procedures Act and whether the Act triggers the Federal Rules of Appellate Procedure absent an agency rule on point.

(7) *Grouping of Claims*

Appellant's brief includes a statement that no claims may be grouped together.

However, as applicant has presented no separate argument on dependent claims 45 and 47 (depending from base claim 38), but a separate 131 affidavit is at issue regarding their base claim 38, Examiner identifies Group I as claims 45 and 47 which rise and fall together and their rejections need inherently stand affirmed upon any affirmation of claim 38. As there is no 131 affidavit explicitly covering claims 45 and 47, an additional ground exists for affirmation of the dependent claims separately from their base claim.

As no separate argument was presented on dependent claims 50-51 and 53 depending from base claim 49, claims 49-51 and 53 rise and fall together and identifies claims 49-51 and 53 as Group II.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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5,562,232	Pearson	10-1996 (priority 8-1991)
5,292,029	Pearson	3-1994 (filed 8-1991)
4,847,764	Halvorson	7-1989
5,883,806	Meador et al.	3-1999 (priority 9-1994)
5,377,864	Blechl et al.	3-1995 (3-1992 filing)

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Rejections evidenced by Pearson '029

1. Claims 48-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Pearson '029. Pearson '029 discloses:

(re: cl 48, as well as 38 per Pearson '232) placing at least one unit of a plurality of types of medical items in a plurality of storage locations, wherein each storage location holds only one type of medical item at a time (c 5 L 14-16);
inputting patient identifying data through at least one data entry device, wherein the patient identifying data corresponds to a patient (c 5 L 14-21);

removing at least one unit of a type medical item from a storage location with a dispenser mechanism (c5 L 32-46);

modifying data in at least one data store through operation of at least one processor, wherein the at least one processor is in operative connection with the at least one data store, the data entry device and the dispenser mechanism, wherein the data is modified responsive to performance of steps (b) and (c) to include data representative of the dispense of the type medical item for the patient (c2 L 32-35; c 5 L 32-46);

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(re: cl 49) receiving user identifying data from a user through at least one input device (c 5 L 14-21);

determining through operation of at least one processor that the user identifying data input in step (a) corresponds to authorized user data in at least one data store that is in operative connection with the at least one processor (c 5 L 14-21);

inputting patient identifying data through at least one input device in operative connection with the at least one processor, wherein the patient identifying data corresponds to a patient (c 5 L 14-21);

inputting medical item data corresponding to a type medical item through at least one input device in operative connection with the at least one processor (c 2 L 29-36);

providing access to at least one of the type medical item to the user from a storage device responsive to performance of at least one of steps (b) and (d) (5 L 22-46);

storing data in at least one data store in operative connection with the at least one processor indicating that the at least one of the type medical item has been provided for the patient (2 L 29-56);

(re: cl 50) step (e) includes dispensing the at least one of the type medical item from a dispenser device (c 5 L 22-46);

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(re: cl 52) step (e) includes releasing the at least one of the type medical item from a device holding such type item (c 5 L 22-46).

Rejections evidenced by Pearson '232.

2. Claims 38-41, 43, and 45-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Pearson '232.

In view of applicant's 131 affidavit on claims 38 and 48, rejections to claims 38 and 48 evidenced by Pearson '232 alone or in combination with other art, rise and fall upon that common subject matter being disclosed in the earlier CIP-linked Pearson '029 application for Pearson '232 to bear the priority date of its great-grandparent application-Pearson '029. Accordingly, the rejections to claims 38 and 48 under Pearson '232 will be evidenced by citations to the CIP linked Pearson '029 ancestor as shown above to demonstrate rejections premised upon priority date antedating the 131 affidavit.

Pearson '232 further discloses:

(re: base of claims 39-47) A method for tracking and dispensing medical items comprising the steps of: placing at least one unit of a plurality of types of medical items in a plurality of storage locations, wherein each storage location holds only one type of medical item at a time (col. 3 L 22-39; c4 L 33-49);

inputting patient identifying data to a data entry device, wherein the patient identifying data corresponds to a patient (col. 2 L 27-34; col. 3 L 5-20);

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removing one unit of a type medical item from a storage location with a dispenser mechanism (suction mechanism #12; col. 5 L 42-col. 6 L 2 ;col. 5 L 9-35; fig 2); modifying a data store using a processor in operative connection with the data store, wherein the processor is in operative connection with the data entry device and the dispenser mechanism, wherein the data store includes data representative of the patient and data representative of the type medical item stored in the storage location (col. 6 L 18-23), and

wherein the data store is modified responsive to the removing step and the inputting step, to include data representative of the dispense of the type medical item for the patient (col. 3 L 5-20; col. 2 L 8-34);

(re: cl 39) the data store further includes data representative of a plurality of authorized users (col. 4 L 60-col. 5 L 8; plurality of nurses (col. 6 L 6-32);

and prior to the removing step further comprising the steps of: receiving user identifying data from a user through a user data entry device, determining with the processor whether the input user identifying data corresponds to data for an authorized user stored in the data store, wherein the processor operatively controls the dispenser device to enable performance of the removing step only when the input user identifying data corresponds to an authorized user (col. 4 L 60-col. 5 L 8);

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(re:cl 40) wherein in the modifying step the data store is further modified to include data representative of a record that the authorized user determined in the determining step dispensed the type medical item (col. 6 L 6-32);

(re:cl 41) prior to the removing step further receiving user identifying data from a further user through the user data entry device and further determining with the processor whether the input user identifying data from the further user corresponds to data for an authorized user stored in the data store, other than the authorized user determined in the first determining step, and wherein the removing step is enabled to be performed only when the data received in the receiving and further receiving steps corresponds to two different authorized users (col. 4 L 60-col. 5 L 8);

(re:cl 43) after the removing step further comprising the step of sensing with a verification sensor the dispense of the type medical item removed in the removing step, wherein the verification sensor is in operative connection with the processor, and wherein the modifying step is not performed if the dispense of the item is not sensed in the sensing step by the verification sensor in the sensing step (col. 5 L 9-47;#42);

(re:cl 45) the removing step includes opening an electronic lock drawer (col. 5 L 1-8);

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(re: cl 46) wherein the removing step includes releasing one container from a magazine holding a plurality of containers (col. 3 L 22-39);

(re: cl 47) wherein the removing step includes opening a lock to enable access to a storage location (col. 5 L 1-8);

(re: cl 49) receiving user identifying data from a user through at least one input device (c 4 L 60-63);

determining through operation of at least one processor that the user identifying data input in step (a) corresponds to authorized user data in at least one data store that is in operative connection with the at least one processor (c4 L 60-63);

inputting medical item data corresponding to a type medical item through at least one input device in operative connection with the at least one processor (c 2 L 29-36);

providing access to at least one of the type medical item to the user from a storage device responsive to performance of at least one of steps (b) and (d) (5 L 1-35);

storing data in at least one data store in operative connection with the at least one processor indicating that the at least one of the type medical item has been provided for the patient (c 4 L 60-67);

(re: cl 50) dispensing the at least one of the type medical item from a dispenser device (c 5 L 1-35);

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(re: cl 51) unlocking a drawer to enable access to the at least one of the type medical item (c3 L 22-61);

(re: cl 52) releasing the at least one of the type medical item from a device holding such type item (c 5 L 1-35)

(re: cl 53) opening the at least one lock to enable access to the storage location (c3 L 22-61).

Rejections premised upon combination of Pearson and Meador et al.

3. Claims 39-43 and 45-47, and 49-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson '232 in view of Meador et al.. Pearson '232 discloses the elements previously discussed and further discloses: receiving manually input data (col. 4 L 60-col. 5 L 8; col. 3 L 5-20). Pearson '232 does not disclose receiving data read from an object. Meador et al. discloses: receiving data read from an object (col. 9 L 12-25). It would have been obvious to substitute the manual data of entry Pearson '232 with the object read data because read data entry is more accurate, faster, and less prone to human input error than manual entry as taught by Meador et al..

Rejections premised upon combination of Pearson and Blechl.

4. Claims 38-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson '232 in view of Blechl et al. '864. Pearson '232 discloses the elements previously discussed but does not disclose: displaying and entering data via a touch

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screen; receiving data read from an object. Blechl et al. teaches: displaying and entering data via a touch screen (col. 4 L 20-38); receiving data read from an object (col. 4 L 3-19). It would have been obvious to display and enter data via a touch screen because a touch screen display is convenient and simple and easier to use than keyboards and takes up no more space than the monitor takes absent the touch screen feature as taught by Blechl et al. '864. It would have been obvious to read data from an object because read data entry is more accurate, faster, and less prone to human input error than manual entry as taught by Blechl et al. '864.

Rejections evidenced by Halvorson

5. Claims 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halverson. Halverson discloses:

(re: cl 48) placing at least one unit of a plurality of types of medical items in a plurality of storage locations, wherein each storage location holds only one type of medical item at a time (c 7 L 10-36);

removing at least one unit of a type medical item from a storage location with a dispenser mechanism (c 3 L 28-63);

modifying data in at least one data store through operation of at least one processor, wherein the at least one processor is in operative connection with the at least one data store, the data entry device and the dispenser mechanism, wherein

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the data is modified responsive to performance of steps (b) and (c) to include data representative of the dispense of the type medical item for the patient (c 5 L 3-25);

(re: cl 49) receiving user identifying data from a user through at least one input device (c 11 L 10 with c4 L 28-32);

determining through operation of at least one processor that the user identifying data input in step (a) corresponds to authorized user data in at least one data store that is in operative connection with the at least one processor (c4 L 27-32);

inputting patient identifying data through at least one input device in operative connection with the at least one processor, wherein the patient identifying data corresponds to a patient (c3 L 15-27);

unlock doors housing drawers of multiple medication type (c3 L 57-60);

inputting medical item data corresponding to a type medical item through at least one input device in operative connection with the at least one processor (c 5 L 35-65);

providing access to at least one of the type medical item to the user from a storage device responsive to performance of at least one of steps (b) and (d) (c 3 L 28-63);

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storing data in at least one data store in operative connection with the at least one processor indicating that the at least one of the type medical item has been provided for the patient (c 5 L 31-6);

(re: cl 50) step (e) includes dispensing the at least one of the type medical item from a dispenser device (c 3 L 28-63);

(re: cl 51) unlocking the doors (c3 L 57-60.)

(re: cl 52) step (e) includes releasing the at least one of the type medical item from a device holding such type item (c 3 L 28-63);

(re: cl 53) opening the at least one lock to enable access to the storage location (c3 L 53-63).

Halverson does not inherently disclose but suggests (see Board's earlier position): inputting patient identifying data through at least one data entry device, wherein the patient identifying data corresponds to a patient (c10 L 1 –c11 L.6 inferred with patient id data). It is inferred and would have been obvious for Halverson to perform the steps associated with this hardware because the patient identifying data is tracked in the system and stored in the memory and the data needs entry to be placed within the system before tracking begins.

Halverson does not disclose: unlocking a drawer to enable access to the at least one of the type medical item, but as the system discloses patient drawers and unlocking doors, it would have been obvious for Halverson to unlock drawers as a

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means of controlling patient specific medications (Board decision in related appeal). As the drawer is behind the computer controlled lock door, it is well within the skill of one in the art to lock the drawer instead of the drawer covering it.

Exceeding Brief Size Constraints

A Petition decision (16) overruling a compliance requirement (paper 13) with FRAP 32(G) 28 U.S.C. Appendix on brief size as triggered by the Administrative Procedures Act was overruled since 37 CFR and 35 USC contain no express brief size limit in ex parte proceedings. The petition did not address, presumably in deference to a Board determination, whether the Administrative Procedures Act 5 USC Section 559 provides a catch-all safety-net triggering the Rules of Appellate Procedure in the absence of an rule on point precluding individuals from gaining extra benefit of process by tilting the playing field and obscuring issues by pursuing a course to overwhelm with volume as a means of compensating and gain allowance on claims not otherwise meriting patentability.

The Administrative Procedures Act was designed to create uniformity with Federal Agencies, FRAP 28(G) was designed to preclude parties from unsurreptitiously gaining an unfair procedural advantage in appeals. The Board should resolve this matter of first impression before the Board and preclude

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applicant's scheme to take public domain technology from the public domain through obscuration and overwhelm.

(11) Response to Argument

The applicant's numerous arguments, newly raised upon appeal, have been fully considered but they are unpersuasive in overcoming the rejections.

131 Affidavit

Applicant presented a 131 affidavit swearing behind the non-CIP priority date of the grandparent application of Pearson '232, not the earlier priority date of the great-grandparent application Pearson '029 to independent claims 38 and 48 only. There was no attempt to swear behind the priority date of Pearson '029. Applicant asserts Pearson '232 not entitled to priority date of Pearson '029 as it is merely a CIP link. A reference is entitled to the priority date of earlier CIP-linked matter commonly disclosed in an earlier application.

There was no attempt to swear behind Pearson '232 on the dependent claims yet applicant attempts to gain the benefit of the base claim invention date on his later invented dependent claims. As technology builds upon earlier developments, the invention of a dependent claim is generally later invented than that of its base claim. Each claim has its own independent invention date. In an effort to overcome obvious rejections in dependent claims, applicant asserts since applicant invented independent claim matter before the Pearson '232 non-CIP priority date, it

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would have been obvious for him to invent the dependent claim matter before Pearson '232, therefore believes he is entitled to 131 date on the dependent claims. Applicant asserted in his claim groupings that no claims rise and fall together, a position clearly repudiating any claims, particularly dependent claims, were patentably indistinct and therefore non-obvious in view of its respective base claim. Applicant may not overcome prior art on subsequently invented claimed subject matter merely because he had capacity to invent earlier than he did. As in *Huston* obvious to invent is insufficient to establish invention for matter not explicitly in hand, one may not establish invention merely premised upon establishment of a portion of invention. *In re Huston*, 308 F.3d 1267, 1277, 64 USPQ2d 1801, 1807 (Fed. Cir. 2002) citing *Lockwood v. Am. Airlines Inc.*, 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) ("Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. It extends only to that which is disclosed.").

Pearson '232 and '029

The applicant asserts a dispensing mechanism 35 of Pearson '232 is not found in Pearson '029. The dispensing mechanism of Pearson '029 at (col. 4 Line 67; fig 3 bottom for dispensing mechanism 35).

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Applicant asserts medication in Pearson is only removed by hand, but a suction mechanism 12 is used to remove the medication (see fig 2).

Applicant assert no verification step performed, but data is modified responsive to removing step, no verification in applicant's claims, modification merely responsive to the step.

(re: cl 39) the data store further includes data representative of a plurality of authorized users (col. 4 L 60-col. 5 L 8)- password of nurse is a clear indication that there is an authorized user access requirement.

(Re: cl 40) Claim does not specify that the determination was verified via sensor, merely that the determination was done via some modifying step which may include the activation by the authorized user.

(re: cl 41) nurse and plurality of patients. The dispenser records which nurse requests the unscheduled medication (col. 6 L 8-23), there being no need to identify which nurse unless a plurality of users were authorized. Under alternate interpretation of users, a plurality of patients are described.

(Re: cl 43) Sensor 42 detects presence and removal of pill at the output end of the dispensing channel. Additionally, sensor (c1 L 51-53, of incorporated by reference prior art) expressly identifies sensing whether medication dispensed.

(re: cl 46) device describes both dispensing of discrete doses and containers rather than discrete pill.

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(re: cl 52) releasing the at least one of the type medical item from a device holding such type item (c 5 L 1-35); argues no release- the removal from the magazine through the tube is a release.

Pearson '029 and '232 clearly disclose recording data in the record keeping of patient scheduled and dispensed medication. Recording data in the computer comprises altering the data in memory. Further, data must be modified to generate the report data.

The recording of the medication dispensed name is evidence of plural types of medications.

The updating of dispensing records fits within applicants broad element of modification of the data.

Meador et al. and Blechl

Re: Meador et al. and Blechl, peripheral interfacing to CPU's has been a standard element of electrical engineering undergraduate curriculums since the late 1970's so modification to interface reading instruments such as bar code readers with a CPU is within the skill of any ordinary electrical engineer in the art.

Halvorson

Regarding the applicant's argument that Halvorson does not explicitly unlock the drawers, the Board previously held it would have been obvious to perform the method steps associated with the apparatus hardware in the manner it

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was clearly intended comprising unlocking a drawer to enable access to the at least one of the type medical item, but as the system discloses patient drawers and unlocking doors, it would have been obvious for Halverson to unlock drawers as a means of controlling patient specific medications (Board decision in related appeal). Data store must be modified to generate the report data.

Applicant has argued his invention features data verification after a step. However, verifying is not claimed, merely performing the step. That an exemplary yet unclaimed embodiment may perform a task differently from the reference, is not at issue in these broad claims encompass both the reference and the claimed elements of the exemplary embodiment. Even if applicant had claimed verification, the nurse in the Pearsons verifies the data with automation of at least some verification process well within the ordinary skill or one in the art.

Summary

Applicant's affidavit does not antedate Pearson '232 because Pearson '232 is entitled to benefit of the filing date of Pearson '029 regarding mutually disclosed subject matter as found in applicant's independent claims.

Applicant's dependent claims do not inherit the invention data of base claims from which they depend.

Pearson '232 and '029 disclose a dispensing mechanism, modification of data, plurality of authorized users, dispensing sensors.

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Pearson '232 discloses dispensing containerized medicaments

Interfacing peripheral readers to CPU's are well within the skill of an electrical engineering in the art.

The PTO is subject to the APA if a rule on point does not exist triggering Rules of Appellate Procedure.

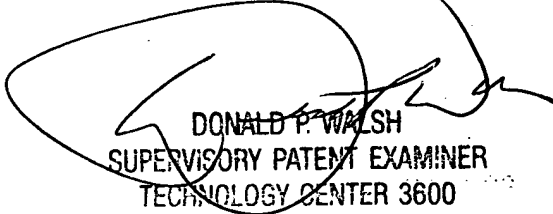
For the above reasons, it is believed that the rejections should be sustained.

Examiner Certifies Preceding Word Count: 4375; Line Count: 441.

Respectfully submitted,

Michael E. Butler

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2/10/03


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